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UNEEDA ROYER
11924 E. 57TH STREET
KANSAS CITY, MO 64133

EXAMINER

HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,935

Applicant(s)

ROLF, DEVON A.

Examiner

Jennifer I. Harle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-3 were pending. Claim 3 was canceled by Applicant's Amendment filed October 27, 2003. Claims 4-49 were added by Applicant's Amendment filed October 27, 2003. Claims 4-49 are rejected and made final. All rejections are necessitated by Applicant's amendment.

Response to Amendment

Rejection Under 35 USC § 102(e)

Applicant's only arguments directed toward the rejection under 35 USC 102(e) is the submission of a 37 CFR 1.131 Declaration. The Examiner has considered the reference, however, the Declaration is insufficient to overcome the reference as set forth below and the rejection of claims 1 and 2 are maintained and made final.

The Declaration filed on October 27, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ausems (US 6,434,403 B1) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the February 19, 1999 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The scope of the declaration is not commensurate with the scope of the claims. Applicant offers as his proof of conception filing of a service mark application filed February 5, 1999, which he filed and also, which he failed to attach, including within the services "facilitating the transaction of retail sales made over a

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communication network;" organization of a limited liability company in Missouri for holding intellectual property; that he worked on this matter in his spare time and that he exercised diligence. This evidence is deficient on several grounds. In the first instance, while the service mark Application was owned by applicant, there is no evidence that he and/or he alone conceived of the services associated with the mark or that he conceived of these particular services. In the second instance, Applicant filed this mark as a service mark for the "intended use" as specifically stated with a "bona fide intention to use the mark in commerce on or in connection with the above -identified services in advertising and in other manners customary to the trade" the specific claims are not in any way shape or form directed towards advertising and Applicant did not state what ways he believed were "customary to the trade." Pg. 1 of Applicant's Trademark Application. As this was an "intent to use" there is no evidence to show or establish anything other than "advertising." In the third instance, the Trademark Examining attorney suggested amending the services that Applicant claims evidence support for conception because the classification and recitation are indefinite, which once again demonstrates lack of support of conception for the claimed invention. Trademark Action No. 1, Pg. 1. In the fourth instance, while prosecuting the Trademark Application, the Trademark Examining Attorney reiterated, in response to Applicant's communication filed on January 22, 2000, that it is unclear what Applicant means by "facilitating transactions of retail sales over a communications network," thus, conception even for service mark purposes at that date was questionable for even a broad category. Applicant's response in the Amendment filed October 9, 2000, was to amend the recitation of services for the other categories but no explanation was ever provided regarding the category, upon which Applicant is basing his support for his Declaration. After

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reinstatement and another action, Applicant amended, June 3, 2002, the services to be “educational services, namely, providing on-line seminars and educational courses in the fields of intellectual property, marketing, brand management and leadership.” Clearly the record shows that all Applicant may have had possession of at the time of filing is something indefinite that dealt with “facilitating the transaction of retail sales made over a communications network.” He was given ample opportunity for clarification and did not do so. Moreover, this vague phrase and the Trademark Application file history does not even demonstrate a mental part of the inventive act nor is there in any way any complete disclosure to another of what is being claimed. Even the patent examiner is unclear about the language used in service mark and how it would convey to anyone how to relate to the requisite means and their interactions, i.e. the systems as claimed, a processor located in a wireless communications device, a transmitter connected to said processor for transmitting wireless communication signals; and a memory connected to said processor, wherein said memory has stored therein data indicative of an account to or against which transaction are accounted, and wherein said device is adapted to wirelessly communicate with at least one terminal and a terminal processor associated with said terminal via a wireless communications link for the purposes of transacting a sale, and wherein data indicative of said account is transmitted via said transmitter to at least one of said remote terminal and said terminal processor as part of said sales transaction. There is nothing in the services that demonstrates the wireless aspect, memory with associated monetary units and the wireless communications device, etc. The filing and establishment of a limited liability company to develop, hold and license intellectual property does not provide any proof of how to solve the problem or convey any aspect associated with the concept of the invention. Clearly, nothing is

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demonstrated about conception of the system claimed by the establishment of the corporation to develop, hold and license intellectual property. It could be any form of intellectual property and does not relate to any specific invention. The assignment of the Patent Application occurs after Ausems filing date and is not an issue for conception.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Ausems reference to either a constructive reduction to practice or an actual reduction to practice. Applicant has not shown that he was diligent from the filing date of the reference to the date of filing of Applicant's provisional application because Applicant merely states that he was diligent and provides no proof of such diligence and that is not sufficient. An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to

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dates and facts.). As set forth above, the service mark application is not even sufficient to establish conception, let alone diligence in reduction to practice for the same reasons.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Ausems reference. The statement alone is deficient for the reasons set forth above. The prosecution of the service mark for the specified services failed to even meet the criteria for conception and fails for the same reasons for reduction to practice. It does not show that the invention was being worked upon as claimed and does not document in any way, shape or form, with any degree of specificity that Applicant was pursuing a system with components, such as the claims. There is no mention of any portable, wireless voice and data communications device, with all the claimed components working in conjunction with a point of sale terminal or a processor located in a wireless communications devices, a transmitter connected to the processor for transmitting wireless communication signals and the memory or any reference to any of the dependent claims. The establishment of the corporation fails for the reasons set forth above for conception and the assignment of the Patent Application as well. Applicant has provided mere conclusory statements and no facts.

Thus, for all the reasons set forth above, the Declaration is insufficient to overcome the Ausems, et al. reference and the rejection of claims 1 and 2 are maintained and made final.

Lexicography

The Examiner notes that Applicant has declined the Examiner's express invitation¹ to be his own lexicographer by indicating and defining claim limitations to have meanings other than

¹ See the Examiner's Previous Office Action, Paper No. 6, mailed April 25, 2003.

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their ordinary and accustom meanings.² Specifically, it is the Examiner's factual determination that Applicant has failed to point to any definition statements in the specification or prosecution history and has failed to point to a term or terms in a claim with which to draw in those statements.³ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process, the presumption in favor of the ordinary and accustom meaning is maintained. The claims are therefore interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁴ The Examiner now relies heavily on this interpretation.⁵ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) ("Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning")(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles apply to all examined claims currently pending.

35 USC § 112 Rejection

Due to Applicant's Amendment dated October 27, 2003, the previous rejection under 35 USC 112 has been withdrawn. Due to Applicant's Amendment, a new rejection under 35 U.S.C. 112 will be set forth below.

² The Examiner's request on this matter was reasonable on at least two independent grounds: first, the Examiner's request was simply an express request for clarification of how Applicants intend their claims to be interpreted. Second, the request was reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, June 3, 2002 available at www.uspto.gov/web/offices/com/strat2001/index.htm.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ See also MPEP §2111; §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

Specification

The use of the trademark "Bluetooth" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology, i.e. short-range wireless connection. The examiner notes that a Federal Registration is still pending, however, it still would receive state law trademark protection and it is a computing and telecommunications industry specification.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 11, 13, 34, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe RFID or Wi-Fi technology to support the newly added claims. Applicant has not pointed out any specific pages where such support can be found. Additionally, WECA did not unveil Wi-Fi, the new consumer brand identity for the IEEE 802.11 High Rate Standard until September 15, 1999 in their press release and the stated first use

⁵ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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is August 1999, while the stated first use in commerce is September 15, 1999 in their certification mark.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's allege that there has been an amendment to claim 1. However, Applicant's Amendment, filed October 27, 2003, while indicating that the claim has been amended, does not show any changes to the claim and a comparison of the claim to the initially filed claim does not show any changes. Therefore, the Examiner needs clarification as to whether claim 1 is considered an amended claim. The Examiner is interpreting this claim as being unamended.

As per claim 2, Applicant's have amended claim 2. However, Applicant's have failed to show/mark all changes to the claim, specifically, the claim used to read "A device comprising:" and now reads "A *system* comprising:". The examiner is interpreting this claim in the same light as a device/apparatus.

3. Claim 12, 13, 35, and 36 contains the trademark/trade name/certification mark "Bluetooth" and "Wi-Fi". Where a trademark, trade name or certification mark is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark, trade name or certification mark cannot be used properly to identify any particular material or product. A

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trademark or trade name is used to identify a source of goods, and not the goods themselves. A certification mark must meet all the criteria for a trademark and includes the standards that determine whether others may use on their goods or in connection with their services. Thus, a trademark, trade name or certification mark does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Bluetooth – housemark for a full line of telecommunication and computer communication equipment and radio modems, telecommunication services, computer communication services, see also designation in ICs 007, 009,010, 011, 012, 016, 028, 037, 038, 041, and 042 for the mark filed May 19, 2000 and Wi-Fi - computer hardware and peripherals, namely, wireless local area networking products, accordingly, the identification/description is indefinite. The examiner notes that “Bluetooth” is still pending as a federal trademark, however, it would be afforded various state trademark protection and it is a computing and telecommunications industry specification that is subject to updates and changes, thus making it indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-5, 7, 9, 10, 12, 14, 16, 21, 24, 27, 28, 30, 32, 33, 35, 37, 39, 44 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Ausems, et al. (6,424,403 B1).

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As per claim 1, Ausems teaches a system comprising:

A portable, wireless voice and data communications device⁶ having a memory and a transmitter, wherein said memory has data indicative of monetary units stored therein (Figs. 2-3; Abstract, cols. 5-6, lines 48-59, col. 7, lines 21-31, cols. 7-8, lines 53-6))⁷; and

A point of sale terminal at which sales are made, wherein data indicative of a selected amount of monetary units associated with a sale are transmitted from said memory to said point of sale terminal or an associated processor to make said sale (Figs. 2-3; Abstract; col. 1, lines 54-65, col. 6, lines 19-44, col. 7, lines 21-31)⁸.

As per claim 2, Ausems teaches a device comprising:

A processor located in a wireless communications device (Figs. 2-3; col. 6, lines 19-44, cols. 7-8, lines 52-7)⁹;

A transmitter connected to said processor for transmitting wireless communication signals (Figs. 2-3; Abstract, cols. 5-6, lines 48-59, cols. 7, lines 21-31, cols. 7-8, lines 53-6)¹⁰; and

⁶ The portable, wireless voice and data communication device is the single integrated device taught by the patent, which combines a wireless telephone, smart-card engine and PDA, as set forth in the Abstract and more specifically in the patent.

⁷ The memory holding the financial data is part of both the PDA and the smart-card chips. It is noted that the smart cards can be housed as part of the device or that the smart-card engine may include the chips only, thus obviating the need for external smart cards. The transmitter is part of the wireless telephone operations engine and is also part of the smart card engine.

⁸ The memory holding the financial data is interconnected, i.e. from the smart card engines/chips and the PDA engine/memory. Data indicative of monetary units is transmitted to either a POS or an associated processor via any one of the engines as set forth.

⁹ The PDA engine contains a CPU which processes information received at the PDA engine, including POS information. Additionally, it is inherent/implicit that a POS system would have a processor as by definition they are computerized transaction systems used to record purchases and as set forth in the reference information is being transmitted back and forth between the two devices in order for purchases to occur. The processor is the device that interprets and executes instructions without it, a POS or other computerized sale device that communicated with the wireless device could not function.

¹⁰ The transmitter is connected to both processors in the reference. It is connected to processor in the wireless device to transmit the initial and any additional required signals to the POS. The transmitter is also connected to the

A memory connected to said processor, wherein said memory has stored therein data indicative of an account to or against which transactions are accounted, and wherein said device is adapted to wirelessly communicate with at least one of a terminal and a terminal processor associated with said terminal via a wireless communications link for the purposes of transacting a sale, and wherein data indicative of said account is transmitted via said transmitter to at least one of said remote terminal and said terminal processor as part of said sales transaction (Figs. 2-3; Abstract, cols. 1-2, lines 54-4, col. 4, lines 43-60, cols. 5-6, lines 48-59, col. 7, lines 17-31, cols. 7-8, lines 53-6).¹¹

As per claim 4, Ausems teaches that the portable, wireless voice and data communications device comprises a cellular telephone (Abstract).

As per claims 5 and 7, Ausems teaches that the portable, wireless voice and data communications device comprises a portable computer, i.e. a Personal Digital Assistant (PDA) (Abstract).

As per claim 9, Ausems teaches that data indicative of a selected amount of monetary units is transmitted wirelessly to said point of sale terminal (col. 6, lines 18-44).

As per claims 10 and 12, Ausems teaches that data indicative of a selected amount of monetary units is transmitted via a Bluetooth link (col. 6, lines 18-44).

As per claim 14, Ausems teaches that data indicative of a selected amount of monetary units is transmitted via a cellular link (col. 7, lines 17-32).

As per claim 16, Ausems teaches that access of data of said device must be identified by input of said user's voice into said device (col. 8, lines 7-13).

processor of the POS because it is capable of receiving information from the POS and downloading it. Thus, either way the claim is interpreted, the limitation is met.

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As per claim 21, Ausems teaches that the point of sale terminal comprises a check-out station at a retail store, i.e. that the smart card engine is configured to communicate with various point of sale terminals and/or other appliances, including a merchant checkout counter (col. 6, lines 19-59).

As per claim 24, Ausems teaches that the transaction is completed while the device is communicating via a voice link with said point of sale terminal (col. 7, lines 9-32, col. 8, lines 17-23 – i.e. the initiation of the address book, 270, in order to initiate a transaction can be voice activated by the wireless telephone engine).

Claims 27, 28, 30, 32, 33, 35, 37, 39, 44 and 47 are rejected for the same reasons as set forth in claims 4, 5, 7, 9, 10, 12, 14, 16, 21 and 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) as applied to claims 1 and 2.

Ausems teaches as set forth above. Additionally Ausems teaches that short-range transceiver enable PDA telephone to establish a wireless link in order to communicate with other devices, including a POS (col. 6, lines 8-59). Ausems teaches the ability for the user to dial phone numbers and subsequently dials the number in order to carry out the transaction. The

¹¹ See footnotes 7-11 for a full explanation of these limitations.

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business practice of using a phone with a sales associate in conjunction with a POS device in order to purchase goods or services is an old and established business practice, i.e. telemarketing and utilizing credit cards or COD payments. This practice is designed to make shopping easier and more convenient for the consumer and to alleviate the costs associated with retail space for the merchants. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Ausems the voice communications with the data transfer of the monetary of units of Ausems to enhance the speed, accuracy and safety of the information being transmitted, in view of the well known business practice of using voice communications as set forth above. Note that as a wireless transmission is occurring and additional user confirmation signals may be required as taught by Ausems for security features, including biometric sensors, which would include voice analysis and as the cell phones/PDAs of Ausems are digital in nature the voice/data link would be digital and all data would travel the same link (col. 6, lines 42-43, col. 8, lines 7-67).

6. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) as applied to claims 1 and 2, and 9 and 33 above in view of Petsinger (6,121,544) and TIRIS News, Texas Instruments, Issue No. 18, 1998, pg. 1.

Ausems teaches as set forth above. Ausems does not teach the use of RFID technology. Petsinger teaches that the chips used in smartcards can be manufactured in a less sophisticated form called an RFID chip, i.e. Radio Frequency Identification, which are now being used in commerce applications (col. 1, lines 41-52). TIRIS News teaches that RFID technology is already being used in with POS devices in gasoline pumps in the U.S. by Mobile in key ring tags and vehicle tags, which prevents cross reading and duplication (pg. 1). Additionally, TIRIS

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teaches that Texas Instruments has teamed up with Verifone to develop an in-store POS RFID reader in order to propel the technology into the retail mainstream (pg. 1). TIRIS, further teaches that RFID is extremely simple for the consumer to use and also an affordable upgrade for the retailer and that the larger retail market is still largely untapped (pg. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the RFID chip/technology in Ausems as taught in Petsinger/TIRIS for the explicit reasons set forth in TIRIS.

7. Claims 15 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) as applied to claims 1 and 2 above in view of Petsinger (6,121,544).

Ausems teaches as set forth above. Ausems teaches that the smartcard engine transmits a user identification number, when it reads the card account information and transmits it to the point-of-sale terminal, as well as the use of biometric identification, etc. coupled to the PDA telephone through the I/O module to provide security features preventing unauthorized users from exploiting the PDA telephone (col. 5, lines 37-40, col. 8, lines 63-67). Ausems does not explicitly teach the use of PIN numbers. Petsinger teaches the use of PIN numbers to prevent access to information stored on chips utilized in smartcards or RFID. Moreover, the business practice of using PIN numbers and entering them into a device to complete a transaction is an old and well-established business practice. This practice is designed to protect the consumer from unauthorized individuals utilizing their accounts. Examples of this practice include the use of ATM/debit cards and passwords on various accounts, including bank/credit card telephone information accounts. It would have been obvious to one of ordinary skill in the art at the time

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of the invention to have utilized PIN numbers in Ausems as taught in Petsingers and in view of its well known business practice as set forth above.

8. Claims 17-20, 21-23 and 40-43, 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) as applied to claims 1 and 2, and 21 and 44 above in view Morrill, Jr. (5,991,749) or Greg Groeller, Gee Whiz Features Aren't so Remote, Orlando Sentinel, May 2, 1999, pg. H1.

Ausems teaches as set forth above. Ausems further teaches that PDA account ledger is configured to automatically balance an electronic account ledger based upon point of sale transactions and that the smart card engine is configured to communicate with various point of sale terminals and/or other appliances, including a merchant checkout counter. However, Ausems does not specifically teach the other types of points of sales terminals, i.e. televisions, vending machine, fast-food drive through, gas pump, restaurant, and on-line store. Morrill, Jr. teaches a wireless voice and data communications system that transmits data indicative of a selected amount of monetary units associated with a sale to a point of sale terminal for purchasing goods and services, specifically turnpike tolls, parking garages, vending machines buying lunch from street vendor (i.e. a restaurant terminal), etc. (cols. 2-4). Morrill, Jr. further teaches that the methods are secure by ensuring account and authorization information, identification of the desired transaction and independent verification of a user's identity, thus protecting the buyer and seller (cols. 1-4). Groeller teaches that wireless phones can be harnessed to purchase goods, including vending machines, carwashes and Laundromats, as well as dialing cash registers. Groeller further teaches that many telecommunications officials agree that the future of communications lies in the wireless industry and that one it overcomes hurdles

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such as cost and its current inability to transmit large quantities of data at once it will supplant phone lines as the primary means of communicating. Ausems does not teach the specific point of sale terminals recited in the claimed invention. However, the specific types of terminals does not patentably distinguish the claimed system. Further, the two additional cited references and Ausems teach multiple different types of point of sale terminals utilized with the systems additionally demonstrating that the type of terminal does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide any type of point of sale terminal in the system taught by Ausems because the type of terminal taught by Ausems is generic and specifically taught to be adaptable, moreover, the functionality does not change with the type of the point of sale terminal and thus does not patentably distinguish the claimed invention.

9. Claims 6, 8, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) as applied to claims 1 and 2 above in view of M C Revett and G J South, Consumer devices for eCommerce Access, CBT Technology Journal, ABI/Inform Global, Vol. 17, No. 3, July 1999, pp. 112-123.

As per claims 6, 8, 28 and 31, Ausems teaches as set forth above. However, Ausems does not teach that the portable voice and data devices could be a laptop or a notebook or a pager. Revett teaches that the portable voice and data devices or mobile computing devices can include laptop, notebook, and handheld PCs, as well as pagers (pg. 115). Revett further teaches that recent changes in access device technology provide greatly increased support for user mobility and estimates that handheld computing will be a \$7.5 billion market by 2003, providing alternative forms of access to eCommerce services, including access to services and charging

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(pg. 115, 117, 119). Additionally, Revett teaches that it is widely predicted that electronic commerce will have a far-reaching impact on businesses in the next few years and that it will be essential that users are able to access and use eCommerce services when and where the wish, at times and places that are convenient to them through access devices that are not standard desktop PCs (pp. 112-113, 115). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used laptops, notebooks and/or pagers in Ausems as taught in Revett for the explicit reasons set forth in Revett and because these access devices are taught as known mobile equivalents of Ausems, also increase the ease of use for consumers in the mobile environment and provide for flexibility.

10. Claims 13 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) and M C Revett and G J South, Consumer Devices for eCommerce Access, CBT Technology Journal, ABI/Inform Global, Vol. 17, No. 3, July 1999, pp. 112-123 as applied to claims 1 and 2 and 6, 8, 28 and 31 and further in view of Wireless Ethernet Compatibility Alliance (WECA) Announces Independent Test Lab and Wi-Fi Technology Brand, September 15, 1999 (Press Release).

Ausems and Revett teach as set forth above. However, neither Ausems nor Revett teach that data indicative of a selected amount of monetary units is transmitted via a wi-fi link. Revett teaches the need for fast data access for mobile users and the spurring of technology advances in wireless networks. Press Release teaches that Wi-Fi is the brand name that was unveiled on September 15, 1999, for the consumer brand identity for the IEEE 802.11 High Rate Standard for those WECA member products that have successfully completed the prescribed interoperability testing and the selection of Silicon Valley Networking Lab Inc. (SVNL) to provide rigorous

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Wireless Lan product interoperability testing. The Press Release further teaches that as more and more companies develop Wireless Lan products, the need to ensure interoperability becomes critical and a trusted third party (SVNL) will help accelerate the transition of Wireless Lan technology into the mainstream, thus rapidly building awareness of the Wi-Fi brand and ensuring that consumers will have peace of mind that their investment is safeguarded and that the product has been proven interoperable with other products bearing the same seal. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a Wi-Fi link in Ausems/Revett as taught in the Press Release for the specific reasons set forth in the Press Release.

11. Claims 26 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems, et al (6,434,403 B1) as applied to claims 1 and 2 above in view of Ching (6,533,168).

Ausems teaches as set forth above. Ausems additionally teaches that sales transaction information is transmitted from the financial institution to the PDA telephone, i.e. a form of an electronic receipt (col. 6, lines 52-55). However, Ausems does not expressly teach that an electronic receipt is transmitted to the device. Ching teaches that digital receipt can be delivered/transmitted to PDAs, hand-held PCs or even cellular telephones (cols. 1-3). Ching further teaches that receipts are important to consumers for tax reporting or expense reimbursement claims purposes and that transmission to the devices is important because it alleviates errors in manual entry and saves the user time/labor, which can be very intensive, resulting in lack of entry and loss of receipts and/or incomplete purchaser transaction records (cols. 1-3). Moreover, Ching teaches that digital receipts are well-known and are even the subject of a previous patent (cols. 2-3, lines 57-2). Thus, it would have been obvious to one of

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ordinary skill in the art at the time of the invention to have delivered/transmitted the electronic receipts to Ausems systems as taught in Ching for the specific reasons set forth above.

Conclusion

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 00/79771 A1 discloses a cellular telephone that utilizes RFID technology in conjunction with POS terminals.

US 5,739,512 discloses the utilization of digital receipts.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their

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lawyers: that patent examiners are abysmal communicators, both orally and in writing,”¹² the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹³ the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner’s position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner’s positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.¹⁴ By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

¹² Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

¹³ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.

¹⁴ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

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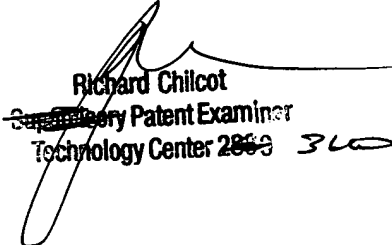
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

Jennifer Ione Harle
January 5, 2004


Richard Chilcot
~~Supervisory~~ Patent Examiner
Technology Center 2869 310